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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,051	06/21/2000	Michael J. Witz	004816.P001	7802

7590 01/27/2004

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EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599051

Applicant(s)

Witz

Examiner

Abers, g

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/3/03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Reply to Response

1. This action is issued in reply to applicant's Response(Paper # 6) filed 11/3/03.
2. No claims were amended. None were added. None were deleted.
3. Claims 1-21 are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21 are rejected under 35 USC 103(a) as unpatentable over Horowitz(US Pat. No: 6,349,290) in view of Maggioncalda(US Pat. No: 5,918,217).
6. As per claims 1-21 Horowitz teaches deriving a financial product from a set of preferences(Abstract)(Fig 1-37).Horowitz teaches an automated system for customized presentation of financial products to a user(Abstract)(col 1 line 65-col 2 line 18)(Fig 1).Horowitz teaches the use of an advice engine(computer) as well as a presentation engine(Fig 12/S12/S13) which are hardware and software based. Horowitz further teaches "mass customization"(col 2 lines 25-30) or consultative services typical of the operation of a mutual fund. Horowitz also teaches a system which supports any interface access as the Internet and wireless and cable(col 2

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lines 52-58). Maggioncalda teaches delivering financial product customization over a network which may include a WAN(Abstract)(Fig 1)(Fig 4)(Fig 13) which also includes screening by a risk rating scale(Fig 14a)(Fig 14b) including setting up a risk portfolio and investing in mutual funds(Fig 12a)(Fig 12b) as well as return on investment(Fig 5A)(col 10 lines 20-30) as well as allocation of funds(col 9 line 29-40) as well as index weighting(Fig 12a/1221/1222) as well as generating a recommended list(Abstract)(Fig 4/430). Maggioncalda teaches a financial advisory system used as a tool for investing which operates over a network(Fig 1) composed of a financial staging server(Fig 1/120) and a broadcast server(115) and a content server(Fig 1/117) and service provider computer(Fig 1/110) all interconnected in a network which could be a WAN, or the Internet(col 6 line 63-col 7 line 5).Maggioncalda teaches receiving user preferences and inputs into the financial advisory system(col 8 lines 6-14) and utilizing this set of risk tolerances appropriate to the user into a decision module to produce recommendations for the user to consider to achieve financial goals(col 8 lines 15-60)(Fig 4).Maggioncalda also teaches the products that produce the desired financial goal(Fig 4/430).Maggioncalda teaches a method of updating a recommended portfolio based on a user specified constraint(Fig 13)(col 17 lines 34-36). It would have been obvious to one skilled in the art at the time of the invention to combine Horowitz in view of Maggioncalda to teach the invention. The motivation to combine is to teach an electronic computer networked system for developing a financial product based on a user's preferences as enunciated by Maggioncalda(col 2 line 33-col 3 line 60).

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Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are further rejected as unpatentable over 35 USC 112(2nd) for failing to specifically claim what applicant regards is the invention. The claims are indefinite. No specificity is provided as to how to derive a financial product from a set of preferences as enunciated in the independent claims nor is there any delineation of the types of user preferences employed.

Response to Arguments

8. Applicant's arguments filed 11/3/03 have been fully considered but they are not persuasive. Maggioncalda teaches a financial advisory system used as a tool for investing which operates over a network(Fig 1) composed of a financial staging server(Fig 1/120) and a broadcast server(115) and a content server(Fig 1/117) and service provider computer(Fig 1/110) all interconnected in a network which could be a WAN, or the Internet(col 6 line 63-col 7 line 5). Maggioncalda teaches receiving user preferences and inputs into the financial advisory system(col 8 lines 6-14) and utilizing this set of risk tolerances appropriate to the user into a decision module to produce recommendations for the user to consider to achieve financial goals(col 8 lines 15-60)(Fig 4). Maggioncalda also teaches the products that produce the desired financial goal(Fig 4/430). Maggioncalda teaches a method of updating a recommended portfolio based on a user specified constraint(Fig 13)(col 17 lines 34-36). Horowitz teaches an automated system for customized presentation of financial products to a user(Abstract)(col 1 line 65-col 2

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line 18)(Fig 1).Horowitz teaches the use of an advice engine(computer) as well as a presentation engine(Fig 12/S12/S13) which are hardware and software based. Horowitz further teaches “mass customization”(col 2 lines 25-30) or consultative services typical of the operation of a mutual fund. Horowitz also teaches a system which supports any interface access as the Internet and wireless and cable(col 2 lines 52-58). Without loss of generality, the “user” may then be a collective group. Horowitz and Maggioncalda then teach providing advice and financial products that address user(aggregate entities) requirements. This construction may then be applied to funding any operations which include empty(naked) funds.

Conclusion

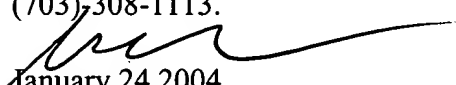
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any questions concerning this communication should be addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the primary examiner are unsuccessful, the primary examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.


January 24, 2004

DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER